



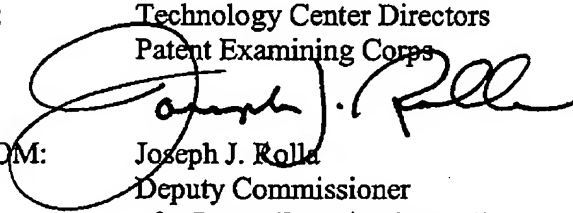
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MEMORANDUM

DATE: June 21, 2005

TO: Technology Center Directors
Patent Examining Corps

FROM: 
Joseph J. Kolla
Deputy Commissioner
for Patent Examination Policy

SUBJECT: Advance notice of changes to MPEP § 719.05 regarding recordation of searches in an application file

One of the initiatives in the USPTO 21st Century Strategic Plan is to enhance the reviewable record. A proper recordation of the search in the application file wrapper will improve the quality of the application file record by accurately reflecting what was searched by the searcher (e.g., examiner) and will permit any person reviewing the application file to reproduce the search performed by the searcher. The procedure for recording search data in an application file currently set forth in MPEP § 719.05 does not accurately reflect what was searched by the examiner since no distinction is made between a classified search and a limited classified search.

This memorandum is to provide advance notice of changes that will be made to MPEP § 719.05 regarding recordation of search. The procedure for recording search data in an application file provided herein is effective immediately. Therefore, any updated searches should be recorded as required below and in the Guidelines for Search Recordation. However, there is no requirement for any prior search to be repeated in any instance. MPEP § 719.05 will be amended in the next revision of the MPEP to incorporate the revised procedure for recording search data in an application file.

(I) Revised Procedure For Recording Search:

1. Distinguish a classified search from a limited classified search.

(a) A classified search is a complete search of all the documents in a particular subclass, whether filed by U.S. or IPC classification and it is not limited by any text query or other means. If a classified search was performed, the class and subclass must be recorded in the "SEARCHED" box section of the OACS "Search Notes" page along with the date that the search was performed (or updated) and the examiner's initials.

Examples:

424/270, 272, 273

224/42.1 F
A61K 9/22
A61K 31/56 to A61K 31/585

Unless a classified search as defined was performed, it would be improper to merely record the class and subclass in the "SEARCHED" box without any indication that a limited classified search was performed. }

(b) A limited classified search is defined as a search of a classified patent document database limited by a text query or a set of text queries or other means. If a limited classified search was performed, the class and subclass followed by an appropriate annotation must be recorded in the "SEARCH NOTES" box section of the OACS "Search Notes" page along with the date that the search was performed (or updated) and the examiner's initials.

Examples:

414/1 (U.S. only)
238/6 (1954 to date)
705/14 (text search only – see search history printout)
4C083 AC10 (F-term, abstract only)
A61B 5/00N4P (ECLA, text search of full doc – see search history printout)
G06F1/2 (text search only – see search history printout)

2. Text search only was performed in a particular database (no classified or limited classified search was performed).

If a text search was performed in a particular database and no classified or limited classified search was performed, the following entry must be recorded in the "SEARCH NOTES" box section of the OACS "Search Notes" page: "See search history printout(s)" along with the date that the search was performed (or updated) and the examiner's initials.

3. Search history printout(s).

Any time that a limited electronic search was performed (i.e., limited classified or text), a complete search history in the form of a printout must be included in the application file. The 3 options that examiners can use to provide the minimum documentation of the electronic search currently set forth in MPEP § 719.05 have been revised to eliminate 2 of the options. The revised procedure requires examiners to provide a complete search history in the form of a printout to be included in the application file. The printout must include the following minimum information:

- (a) all the search logic or chemical structure or sequence(s) used as a database query;
- (b) all the name(s) of the file(s) searched and the database service;
- (c) the date the search was made or updated; and

(d) the examiner's initials.

It would be improper to merely list the tool/database, e.g., "EAST" or identify the search queries in the "SEARCH NOTES" box section of the OACS "Search Notes" page. A search history printout should be devoid of result printouts to limit the "bulk search printouts."

Regarding nucleotide and peptide sequence searches, these searches must be documented by printout(s). A copy of a printout for each database source searched must be included in the application file. Each printout must include all the information up to the "ALIGNMENTS" section.

(II) Information To Be Printed Under "Field of Search" On the Patent Front Page:

In view of the revised procedure for recordation searches, it would not be practical to include all the information provided in the "SEARCHED" box, "SEARCH NOTES" box and the printout(s) on the front page of a patent. Therefore, beginning at a later date, instead of the current class and subclass information, the "Classified Field of Search" and the statement "See application file for the complete search history" will be printed on the front page of issued patents.